UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,725	01/27/2000	Robert G. Arsenault	PD-980142	1296

20991   7590   06/18/2003

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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/18/2003

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 10

Application Number: 09/492,725
Filing Date: January 27, 2000
Appellant(s): ARSENAULT ET AL.

MAILED

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GROUP 3600

Frankie Ho
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on May 16, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is deficient because the summary of

invention represents the summary of the claimed invention as a whole, not a synopsis of every

single claim in the Instant Application.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

Claims 18-47 stand or fall together.

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

US Patent 5, 774, 170   *Hite et al.*   *06-30-1998*

(10)   Grounds of Rejection

Claims 18-40 and 41-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Hite

et al., US Patent 5,774, 170A.

As per claim 18, Hite et al. disclose an enhanced television (radio) advertising method

and/or system by targeting, delivering and displaying advertisements within specified

programming, during program breaks, in pre-determined households having specific and

addressable units while preventing advertisements from being displayed in other households (See

abstract). The system comprising appropriate hardware and software (first software, second

software, third software) wherein an Ad Administration Facility having stored therein

advertisements and programs for analysis and classification and the results of this analysis and

classification are stored in databases. In addition, advertisements or commercials are received

from agencies that created them and processed them as necessary for use in the system. These

processed commercials (first group or first source of advertisements) having associated CID

codes (commercials ID) constructed from information or results stored in databases associated

with the Administration Facility 100 of fig. 1 are conveyed or transmitted to Ad Transmission

Facility 200, which combines the processed commercials and CID codes with programming and

transmits the result to a plurality of Media Origination Facility 300 for delivery to the display site

(reception site) 400 based on the viewer's interest. The Media Origination Facility 300 also

receives programming and commercials from other sources (second group of commercials) and

creates some programming and commercials in its own facilities wherein these commercials and

programming are scheduled to be transmitted to the viewer's unit based on his demographic and

psychographic profile. Further, a viewer is targeted with a list of advertisements from the first

group or second group based on his profile and the advertisements will be displayed in a correct

sequence according to a sequencing code store at the point of viewing (fig. 1; col. 8: 63 to col. 9:

42; col. 3: 65 to col. 4: 2; col. 4: 45-51; col. 8: 29-38).

Moreover, Hite discloses, in general, a system to display advertisements, stored on a set

top box, on a viewer's unit or TV screen based on the viewer's profile when a breaks occurs

during the broadcast of a TV show or a programming. The displayed advertisements comprising

text and/or audio and/or video (image objects or graphical representation) formats as inherently

practiced in the television industry and known to those skilled in the art. Additionally,

advertisements are commonly associated with objects, such as graphical images, stored on

computer readable media as a file within a directory (See abstract; col. 3: 16 to col. 8: 43).

Finally, Hite discloses a system wherein a viewer is targeted with a list of advertisements

based on his profile and wherein the advertisements will be displayed in a correct sequence

according to a sequencing code stored at the point of viewing (viewer's set top box). Indeed, a

sequencing code would be stored at the point of display. It would be used to compute a new CID

(commercial ID) code for a subsequent commercial or advertisement object. **By having a**

sequential CID code, viewer would see a series or list of commercials in correct order (col.

4: 45-51).

See col. 3: 16 to col. 8: 43 for more details.

As per claims 19-23, Hite et al. disclose an enhanced television (radio) advertising

method and/or system by targeting, delivering and displaying advertisements within specified

programming, during program breaks, in pre-determined households having specific and

addressable units while preventing advertisements from being displayed in other households (See

abstract). The system comprising appropriate hardware and software wherein an Ad

Administration Facility having stored therein advertisements and programs for analysis and

classification and the results of this analysis and classification are stored in databases. In

addition, advertisements or commercials are received from agencies that created them and

processed them as necessary for use in the system. These processed commercials (first group or

first source of advertisements) having associated CID codes (commercials ID) constructed from

information or results stored in databases associated with the Administration Facility 100 of fig.

1 are conveyed or transmitted to Ad Transmission Facility 200, which combines the processed

commercials and CID codes with programming and transmits the result to a plurality of Media

Origination Facility 300 for delivery to the display site (reception site) 400 based on the viewer's

interest. The Media Origination Facility 300 also receives programming and commercials from

other sources (second group of commercials) and creates some programming and commercials in

its own facilities wherein these commercials and programming are scheduled to be transmitted to

the viewer's unit based on his demographic and psychographic profile. Finally, a viewer is

targeted with a list of advertisements from the first group or second group based on his profile

and the advertisements will be displayed in a correct sequence according to a sequencing code

store at the point of viewing (fig. 1; col. 8: 63 to col. 9: 42; col. 3: 65 to col. 4: 2; **col. 4: 45-51;**

col. 8: 29-38).

See col. 3: 16 to col. 8: 43 for more details.

As per claim 24, Hite et al. disclose an enhanced television (radio) advertising method

and/or system by targeting, delivering and displaying advertisements within specified

programming, during program breaks, in pre-determined households having specific and

addressable units while preventing advertisements from being displayed in other households (See

abstract). A suitable process is used to target prospective viewers of a set of advertisements using

database search and list selection procedures. The result of this process is a set of appropriate

CID codes for the prospective viewers. These CID codes are transmitted to the viewing device or

unit where it is stored and subsequently used to match CID transmitted with advertisements

embedded in a programming. When a match is found between the locally stored CID and the

CID (commercial ID) transmitted with the advertisement or commercial, the commercial is then

presented to the viewer. If there is no match, the commercial is ignored and not displayed (col. 3:

65 to col. 4: 18; col. 8: 29-38). Moreover, Hite discloses, in general, a system to display

advertisements, stored on a set top box, on a viewer's unit or TV screen based on the viewer's

profile when a breaks occurs during the broadcast of a TV show or a programming. The

displayed advertisements comprising text and/or audio and/or video (image objects or graphical

representation) formats as inherently practiced in the television industry and known to those

skilled in the art. Additionally, advertisements are commonly associated with objects, such as

graphical images, stored on computer readable media as a file within a directory (See abstract;

col. 3: 16 to col. 8: 43).

As per claims 32-34, Hite et al. disclose an enhanced television (radio) advertising

method and/or system by targeting, delivering and displaying advertisements within specified

programming, during program breaks, in pre-determined households having specific and

addressable units while preventing advertisements from being displayed in other households (See

abstract). A suitable process is used to target prospective viewers of a set of advertisements using

database search and list selection procedures. The result of this process is a set of appropriate

CID codes for the prospective viewers. These CID codes are transmitted to the viewing device or

unit where it is stored and subsequently used to match CID transmitted with advertisements

embedded in a programming. When a match is found between the locally stored CID and the

CID (commercial ID) transmitted with the advertisement or commercial, the commercial is then

presented to the viewer. If there is no match, the commercial is ignored and not displayed (col. 3:

65 to col. 4: 18; col. 8: 29-38).

As per claim 25-31 and 36-40, Hite et al. disclose an enhanced television (radio)

advertising method and/or system by targeting, delivering and displaying advertisements within

specified programming, during program breaks, in pre-determined households having specific

and addressable units while preventing advertisements from being displayed in other households

(See abstract). When a match is found between the locally stored CID and the CID (commercial

ID) transmitted with the advertisement or commercial, the commercial is then presented to the

viewer. If there is no match, the commercial is ignored and not displayed and a default

advertisement in the batch of locally stored advertisements having a low priority is considered

unless it is replaced with a higher priority commercial (col. 3: 65 to col. 4: 18). Moreover, an

unconditional preemptable commercial may be subject to substitution or replacement whenever

other higher priority commercials are available (col. 3: 55-57; col. 8: 29-38). Advertisements are

transmitted and stored locally in a viewer's unit along with suitable CIDs to be subsequently

presented to the viewer. A broadcast with a break to present a targeted commercial may then be

transmitted with codes or CIDs in the break point. If there is a match between the stored CIDs

and the transmitted CIDs, an appropriate commercial is presented, perhaps more than once. If a

certification or registration code is included, that code is returned upstream to the signal

origination site when commercials are successfully presented. **The presented or used**

commercial will then be replaced with another commercial or a new commercial, which is

just received and stored in the viewer's unit, thereby updating the local database or local

storage medium associated with the viewer's unit and especially if the newly received

advertisement has similar content as the previously viewed advertisement. Further, when there is

no match between the stored CID and the received CID associated with the commercial break

embedded in the transmitted program, no commercial will be displayed. However, there is

always a default advertisement to be displayed. In the case of multiple matches, a prioritization

programming will be employed to determine which commercials to be displayed and which ones

to ignore. It is to be understood that each advertisement stored in the system to be displayed at

the appropriate time has an expiration date and at the end of the expiration date, the

advertisement will no longer to be displayed. In the end, the current system has the necessary

hardware and software to replace a previously viewed advertisement with a newly transmitted

advertisement, to ignore inappropriate advertisement and display a default one having a low

priority, to select the advertisement having the highest priority in the case of multiple matches

(col. 5: 39- col. 8: 38).

As per claim 35, Hite et al. disclose an enhanced television (radio) advertising method

and/or system by targeting, delivering and displaying advertisements within specified

programming, during program breaks, in pre-determined households having specific and

addressable units while preventing advertisements from being displayed in other households (See

abstract). When there is no match between the stored CID and the received CID associated with

the commercial break embedded in the transmitted program, no commercial will be displayed.

However, there is always a default advertisement to be displayed. In the case of multiple

matches, a prioritization programming will be employed to determine which commercials to be

displayed and which ones to ignore, thereby creating at least one list **or first order** list of

advertisements that will be presented on the user's unit or TV in a certain sequence or order

according to this prioritization programming **(col. 4: 45-51**; see claims 10, 16, 54 and 59 of the

current reference).

Moreover, Hite discloses, in general, a system to display advertisements, stored on a set

top box, on a viewer's unit or TV screen based on the viewer's profile when a breaks occurs

during the broadcast of a TV show or a programming. The displayed advertisements comprising

text and/or audio and/or video (image objects or graphical representation) formats as inherently

practiced in the television industry and known to those skilled in the art. Additionally,

advertisements are commonly associated with objects, such as graphical images, stored on

computer readable media as a file within a directory (See abstract; col. 3: 16 to col. 8: 43).

Finally, Hite discloses a system wherein a viewer is targeted with a list of advertisements

based on his profile and wherein the advertisements will be displayed in a correct sequence

according to a sequencing code stored at the point of viewing (viewer's set top box). Indeed, a

sequencing code would be stored at the point of display. It would be used to compute a new CID

(commercial ID) code for a subsequent commercial or advertisement object. **By having a**

sequential CID code, viewer would see a series or list of commercials in correct order (col.

4: 45-51).

As per claim 41, Hite et al. disclose an enhanced television (radio) advertising method

and/or system by targeting, delivering and displaying advertisements within specified

programming, during scheduled program breaks, in pre-determined households having specific

and addressable units while preventing advertisements from being displayed in other households

(See abstract). The system comprising appropriate hardware and software (first software, second

software, third software) wherein an Ad Administration Facility having stored therein

advertisements and programs for analysis and classification and the results of this analysis and

classification are stored in databases. In addition, advertisements or commercials are received

from agencies that created them and processed them as necessary for use in the system. These

processed commercials (first group or first source of advertisements) having associated CID

codes (commercials ID) constructed from information or results stored in databases associated

with the Administration Facility 100 of fig. 1 are conveyed or transmitted to Ad Transmission

Facility 200, which combines the processed commercials and CID codes with programming and

transmits the result to a plurality of Media Origination Facility 300 for delivery to the display site

(reception site) 400 based on the viewer's interest. The Media Origination Facility 300 also

receives programming and commercials from other sources (second group of commercials) and

creates some programming and commercials in its own facilities wherein these commercials and

programming are scheduled to be transmitted to the viewer's unit based on his demographic and

psychographic profile. Further, a viewer is targeted with a list of advertisements from the first

group or second group based on his profile and the advertisements will be displayed in a correct

sequence according to a sequencing code store at the point of viewing (fig. 1; col. 8: 63 to col. 9:

42; col. 3: 65 to col. 4: 2; col. 4: 45-51; col. 8: 29-38).

Moreover, Hite discloses, in general, a system to display advertisements, stored on a set

top box, on a viewer's unit or TV screen based on the viewer's profile when a breaks occurs

during the broadcast of a TV show or a programming. The displayed advertisements comprising

text and/or audio and/or video (image objects or graphical representation) formats as inherently

practiced in the television industry and known to those skilled in the art. Additionally,

advertisements are commonly associated with objects, such as graphical images, stored on

computer readable media as a file within a directory (See abstract; col. 3: 16 to col. 8: 43).

Finally, Hite discloses a system wherein a viewer is targeted with a list of advertisements based on his profile and wherein the advertisements will be displayed in a correct sequence according to a sequencing code stored at the point of viewing (viewer's set top box). Indeed, a sequencing code would be stored at the point of display. It would be used to compute a new CID (commercial ID) code for a subsequent commercial or advertisement object. **By having a sequential CID code, viewer would see a series or list of commercials in correct order** (col. 4: 45-51).

See col. 3: 16 to col. 8: 43 for more details.

As per claims 42, 44, 45, 46 and 47, Hite discloses, in general, a system to display advertisements, stored on a set top box, on a viewer's unit or TV screen based on the viewer's profile when a breaks occurs during the broadcast of a TV show or a programming. The displayed advertisements comprising text and/or audio and/or video (image objects or graphical representation) formats as inherently practiced in the television industry and known to those skilled in the art. Additionally, advertisements are commonly associated with objects, such as graphical images, stored on computer readable media as a file within a directory (See abstract; col. 3: 16 to col. 8: 43).

Finally, Hite discloses a system wherein a viewer is targeted with a list of advertisements based on his profile and wherein the advertisements will be displayed in a correct sequence according to a sequencing code stored at the point of viewing (viewer's set top box). Indeed, a sequencing code would be stored at the point of display. It would be used to compute a new CID (commercial ID) code for a subsequent commercial or advertisement object. **By having a**

sequential CID code, viewer would see a series or list of commercials in correct order (col.
4: 45-51).

See col. 3: 16 to col. 8: 43 for more details.

As per claim 43, Hite et al. disclose an enhanced television (radio) advertising method

and/or system by targeting, delivering and displaying advertisements within specified

programming, during scheduled program breaks, in pre-determined households having specific

and addressable units while preventing advertisements from being displayed in other households

(See abstract; col. 3: 1-10).

(11)   *Information Disclosure Statement*

The information disclosure statement filed on March 18, 2003 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because, as set forth in 1.97(d) (e), no petition

requesting consideration of the IDS along with the petition fee under 1.17(i) was included. It has

been placed in the application file, but the information referred to therein has not been

considered as to the merits. Appellant is advised that the date of any re-submission of any item

of information contained in this information disclosure statement or the submission of any

missing element(s) will be the date of submission for purposes of determining compliance with

the requirements based on the time of filing the statement, including all certification

requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

(12) Response To Arguments

First of all, in general, Appellant argues, in part A of the Appeal Brief, that the Examiner defines the term "object" as used in the terms "advertising objects" and "image object" as recited in claims 18-47 as video images, shapes or the like that are visually perceived or viewed by a human. Further, the Appellant had spent considerable amount of time trying to explain the claimed invention and more particularly the meanings of the terms "advertising object" and "image object" in light of the specification and allegedly concluded that the Examiner has failed to consider the terms "advertising object" and "image object" in light of the specification, as required under the law. The Examiner respectfully disagrees with the Appellant's findings. In fact, the terms "advertising object" and "image object", as presented in the claimed invention, are considered to be graphical image, video images that can be perceived and viewed by a human or user when they are displayed on a screen. The terms "advertising object" and "image object" are commonly used in the art by professionals and are given similar interpretation; in other words, those are common terms with well-established and well-defined meanings accepted in the industry. Although, the Appellant, under the law, can be creative, however the Appellant should not try to redefine or alter the meanings of commonly used terms or phrases. And if after a First Office Action on the merits is issued, the Appellant realizes that the Examiner has applied a common definition or interpretation to a term or phrase used in the claimed invention, it is the Appellant's responsibility to amend the claimed invention to thereby clarify the claim language, especially if this term or phrase is well-established in the art, that is having a common meaning. Further, The term object, as presented in "advertising object" and "image object", is a software entity that represents physical material like a person, a car, a truck, text and so on; in other

words, the "advertising object" and/or "image object", that is the video, the graphical image or

the physical material or text displayed on the viewer's TV monitor during a programming break,

are retrieved from the uniquely addressable digital recording device (RD) associated with the

viewer's set-top box where they were stored in a digital compressed format (software entity)

(See Hite's-col. 6: 60 to col. 7: 17). Hite does implicitly disclose the use of "advertising object"

and "image object", as commonly used in the art. In addition, features that are inherent in the art

or widely used in the industry need not be disclosed in a reference in order for these features to

be anticipated by the current prior art; in other words, failure of those skilled in the art to

contemporaneously recognize an inherent property, function or ingredient of a prior art does not

preclude a finding of anticipation (MPEP 2131.01 (III).

Furthermore, after reviewing the Appellant's arguments, the Appellant had not concisely

pointed out the difference between the prior art and the claimed invention. Contrary to

Appellant's conclusion, the Examiner did in fact read the specification. Although, the Examiner

does interpret the claims in light of the specification, the Examiner does not read limitations from

the specification into the claimed invention (See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993)). Arguendo, even if the Examiner were to read limitations from

the specification into the claims, a clear violation of the patent law, the connotations or

interpretations given to the terms "advertisement object" and "image object", as implicitly

supported in the prior art, would still be applied.

Second of all, Appellant contends that the fact that "advertising object" and "image

object" as recited in the claimed invention can be used to generate perceptible video images does

not mean that the terms "advertising object" and "image object" are to be construed as such and

when construed in light of the specification, "advertising object" and "image object" refer to digital data structure. In light of the above arguments, Appellant seems to agree with the Examiner that "advertising object" and "image object", indicative of video, graphical images, shapes or physical material, are perceived or viewed by the viewer and retrieved from a digital recorder or readable medium (RD) corresponding to the viewer's set-top box where the "advertising object" and/or "image object" are stored in digital compressed format (digital structure or software entity written using, for instance, object oriented programming language like C++). Here, if the prior art structure is capable of performing an intended use, then it meets the claimed invention. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art (See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Third of all, Appellant, in part B of the Appeal Brief, argues that Hite does not inherently disclose a linkage between "advertising object" and "image object", nor would it be an **obvious** design choice to modify the system taught by Hite to include such a linkage. Technically speaking, the latter arguments are incorrect. The claims, as presented in the last Office Action, were rejected under 35 U.S.C 102 (e), not under 35 U.S.C 103(a). Indeed, Some of the limitations recited in the claims are inherent or anticipated, but not obvious. Furthermore, it appears that the terms "advertising object" and "image object", as recited in the claimed invention and described on page 4 of the specification, can be used interchangeably. Once again, the term object, as presented in "advertising object" and "image object", is a software entity stored on the digital recorder (RD) representing physical material like a person, a car, a truck,

text and so on displayed on the viewer's TV monitor; in other words, the "advertising object" and/or "image object", that is the video, the graphical image or the physical material, text displayed on the viewer's TV monitor during a programming break, are retrieved from the uniquely addressable digital recording device (RD) associated with the viewer's set-top box where the "advertising object" and/or "image object" were stored in a digital compressed format (software entity) (See Hite's- Col. 6: 60 to col. 7: 17). Here, the "advertising object" and/or "image object" are stored in the digital recording device (RD) in a digital compressed format, thereby using the storage capacity or memory efficiently. In other words, the "advertising object" and/or "image object" are supported by a software program used to present a digital structure or representation of the "advertising object" and/or "image object" prior to storing the "advertising object" and/or "image object" in the digital recording device (RD) where different schemes or programming techniques may be used to prepare the digital structure of the "advertising object" and/or "image object" and/or to perform the storage including file or object compression, file or object linking and so on, as understood by those skilled in the art of computer programming or object-oriented programming.

Moreover, it appears that the latter arguments are directed towards an object-oriented programming. In any event, linking one object to another is inherently practiced in the field of object-oriented programming. In practice, one object may request the presence of another object to perform a particular task (See enclosed US Patent 6, 519,584- col. 1: 22-55). The fact that Hite does not explicitly mention linking "advertising object" to another object (cross-linking) does not necessarily mean that linking one object to another is not implicitly supported in the prior art. In fact, features that are inherent in the art or widely used in the industry need not be disclosed in a

reference in order for these features to be anticipated by the current prior art; in other words,

failure of those skilled in the art to contemporaneously recognize an inherent property, function

or ingredient of a prior art does not preclude a finding of anticipation (MPEP 2131.01 (III).

Finally, the law makes it clear that an inventor can receive a patent for a novel or

non-obvious concept or for an improvement on an existing technology.

Therefore, Appellants' arguments, as described herein, are not plausible and the

Appellant's request for allowance or reconsideration has been respectfully denied.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
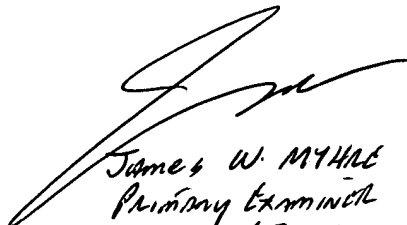
Jean D Janvier
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